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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/971,344 11/17/97 GOELET

P 04990.0008-2

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HM22/0505

EXAMINER

SISSON, B

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

05/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

### Office Action Summary

Application No.

08/971,344

Applicant(s)

GOELET ET AL.

Examiner

Bradley L. Sisson

Art Unit

1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

#### Status

- 1) ☐ Responsive to communication(s) filed on 13 April 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 54-126 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims 54-126 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

#### Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)                      17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      18) ☐ Notice of Informal Patent Application (PTO-152)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      19) ☐ Other: \_\_\_\_\_

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*Location of Application*

1. The location of the subject application has changed. The subject application is now located in Group 1650, Art Unit 1655, and has been assigned to Primary Examiner Bradley L. Sisson.

*Continued Prosecution Application*

2. The request filed on 21 December 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/971,344 is acceptable and a CPA has been established. An action on the CPA follows.

*Election/Restrictions*

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 54 and 55, drawn to genetic marker set, classified in class 536, subclass 23.1.
  - II. Claims 56-70, drawn to method of preparing a genetic marker set from a species of interest, classified in class 436, subclass 94.
  - III. Claims 71 and 72, drawn to a method of genotyping an individual; claims 73-81, drawn to a method of determining the number of matching SNP alleles between DNA from target individual and DNA from a reference individual of the same species; and, classified in class 435, subclass 6.
  - IV. Claim 82, drawn to a method of establishing the genetic similarity of two or more individuals from a species of interest; claims 83-86 and 107-112, drawn to a

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method for determining the probability that an unknown sample of nucleic acid molecules is derived from a known individual; claims 87-90, drawn to a method for excluding the possibility that an unknown sample of nucleic acid molecules are derived from an unknown individual; and claims 91-93 and 107-112, drawn to a method of excluding the possibility that an individual is the progeny of a possible ancestor, classified in class 436, subclass 94.

- V. Claims 94-98 and 107-112, drawn to a method of generating a genetic map of an individual; claims 99, 100 and 107-112, drawn to a method for determining the probability that a target individual will have a particular trait; a method of associating the presence of a particular trait of interest found in an individual with a particular allele found at a SNP site, classified in class 436, subclass 94.
- VI. Claims 113-119, drawn to a method of identifying single nucleotide polymorphic sites in a genome of a species of interest; and claims 120-126, drawn to a method for determining allelic frequency at a SNP site, classified in class 436, subclass 94.

The inventions are distinct, each from the other because of the following reasons:

- 4. Inventions II-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are all drawn to different methods having different modes of operation and which result in different end products.

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5. Inventions I and III-VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in any of methods III-IV.

6. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by solid phase synthesis.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because these inventions have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

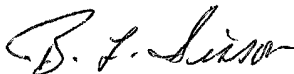
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*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on Monday through Thursday from between the hours of 6:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7230.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
BRADLEY L. SISSON  
PRIMARY EXAMINER  
GROUP 1800 1650  
5/3/00